

Appln No. 10/674,654
Amdt date July 24, 2007
Reply to Office action of April 24, 2007

REMARKS/ARGUMENTS

Claims 1-30 are now in the application. The Applicant respectfully requests reconsideration and allowance of the application in view of the amendment and the following remarks.

Allowable Subject Matter

Claims 1-27 and 29-30 would be allowable upon overcoming the nonstatutory double patenting rejection.

Nonstatutory Double Patenting Rejection

Claims 1-30 are provisionally rejected under the nonstatutory obviousness-type double patenting as being unpatentable: over Claims 1-9 of co-pending application Serial No. 11/255,136; over Claims 1-19 of co-pending application Serial No. 11/206,706; and over Claims 1-21 of co-pending Application Serial No. 11/298,113. The Examiner further provides that a timely filed Terminal Disclaimer would overcome this rejection.

While a Terminal Disclaimer is available to overcome obviousness-type double patenting, the Applicant submits that given that the present application was filed on September 29, 2003, and given that the cited co-pending application 11/255,136 was filed on October 19, 2005, the cited co-pending application 11/206,706 was filed on August 17, 2005 and the cited co-pending application 11/298,113 was filed on December 8, 2005, any requisite Terminal Disclaimer, if needed, would be in the later-filed co-pending applications, not in the present application, which was the earliest filed. Accordingly, the Applicant respectfully requests that the provisional double-patenting rejection in the present application be withdrawn, and that Claims 1-27 and 29-30 be allowed. See MPEP § 804.¹

¹ If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. * * * If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer.

Claim Rejection Under 35 U.S.C. 102(e)

Claim 28 is rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Yuichiro et al., Japanese Patent Application No. 2000-205037.²

The Applicant respectfully traverses this rejection.

Specifically, independent Claim 1 recites an image defect inspection apparatus comprising, among other things:

* * *

a defect detection section for comparing the detected gray level difference with a threshold value and judging the part to be a defect when the gray level difference is larger than the threshold value,

wherein the difference image detection section detects positive- or negative-signed gray level differences,

wherein said apparatus further comprises: an average calculation section for calculating the average of the signed gray level differences; a correction section for calculating signed corrected gray level differences by correcting the signed gray level differences with the calculated average; and an absolute-value conversion section for calculating absolute-value corrected gray level differences without sign from the signed corrected gray level differences, and

wherein the defect detection section compares the absolute-value corrected gray level differences with the threshold value (emphasis in underline added).

As such, the Applicant submits that Claim 28 is not anticipated by Yuichiro under 35 U.S.C. §102.

That is, as recited in the first "wherein" clause (or element) of Claim 28, "positive- or negative-signed gray level differences" are detected, and the second and third "wherein" clauses (or constitutional elements) of Claim 28 carry out the inspection processes based on the signed gray level differences.

² The Applicant respectfully notes that since Yuichiro is not filed in the United States or filed as an International Application under section 351(a) in the English language, Claim 28 should not have been rejected under 35 U.S.C. §102(e) (and the Office Action may have intended to reject Claim 28 under 35 U.S.C. §102(b)).


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Yuichiro does not provide a description regarding "the signed gray level differences" as recited in Claim 28. Instead, according to Yuichiro, "[a]n absolute value image A generated based on the difference image U is used in the conversion." See lines 7-9 from the top of the "solution" in Yuichiro. As such, Yuichiro does not disclose or even suggest the above described (signed gray level differences) recitations in Claim 28.

At least for the reasons explained above, the Applicant respectfully submits that a *prima facie* case of anticipation has not been established because Yuichiro does not disclose each and every limitation of the present Claim 28. See MPEP § 2131 and see also *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F. 2d 1573, 1576 (Fed. Cir. 1991) (i.e., there must be no difference between the claimed invention and the reference disclosed). As such, the Applicant respectfully requests that the rejection of Claim 28 be withdrawn and that this claim be allowed.

In view of the foregoing, the Applicant respectfully submits that Claims 1-30 are in condition for allowance. Reconsideration and withdrawal of the rejections are respectfully requested, and a timely Notice of Allowability is earnestly solicited. If there are any remaining issues that can be addressed over the telephone, the Examiner is encouraged to call the Applicant's attorney at the number listed below.

Respectfully submitted,
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